

REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Final Office Action mailed on January 30, 2006, and the references cited therewith.

Claims 1, 7-8, and 19-20 are amended, and claims 3-6, 14, 22-25, and 28-31 were previously canceled; as a result, claims 1, 2, 7-13, 15-21, and 26-27 are now pending in this application.

§ 112 Rejection of the Claims

Claim 1 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claim 1 in order to more clearly define and recite the subject matter therein. Applicant respectfully submits that claim 1 is now in accordance with 35 USC § 112. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112 rejection.

§103 Rejection of the Claims

Claims 1, 2, 7-10, 13, 15, 16-18, 21, 26, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Kurata et al (U.S. Patent No. 4,518,999). Applicant respectfully traverses the rejection as set forth below.

Independent Claim 1

As mentioned above, Applicant has amended independent claim 1 to particularly point out and distinctly claim the subject matter therein in accordance with § 112.

With respect to the § 103(a) rejection of claim 1, the Examiner cites column 1, lines 23-25 of the Kurata reference as disclosing cursors of an imaging apparatus used to designate a region on a platen. In column 1, lines 23-25, the Kurata reference states, "Fig. 1 shows a conventional picture image position setting apparatus in which a desired region of an original document can be directly

designated on a platen.” At column 1, lines 30-33 and lines 42-51, the Kurata reference states:

The . . . apparatus is provided with cursors 3, 4, 5, and 6 . . . for performing positioning operations in the X and Y directions. . . . When the X-direction cursors 3 and 4 are moved . . . detector elements . . . move following the cursors 3 and 4 to be properly positioned at the starting and end points . . . to provide these starting and end points as inputs to the system. . . .

By stating this, the Kurata reference appears to describe a conventional imaging apparatus in which the physical location of cursors may be detected to determine the point at which a reading element passes the cursors.

Furthermore, Kurata discloses that in conventional imaging systems voltages corresponding to the starting and end positions in the Y-direction can result in poor accuracy due to the use of a slide resistor. (column 1, lines 52-67). At column 2, lines 27 -30, the Kurata reference appears to describe a conventional imaging system that seeks to overcome this poor accuracy by providing a system in which “A circuit is provided for converting picture image information with respect to the position designating cursor which has been read into positional information in the main scanning direction.” (column 2, lines 27-30). The Kurata reference does not describe, teach, or suggest “a scan window illumination device, wherein at least one of the plurality of moveable position markers includes a light source on the at least one of the plurality of markers and configured to direct light into at least one of the sides of the member,” as recited in Applicant’s independent claim 1, as amended.

The Examiner also states, “Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore, it would have been obvious . . . to provide light emission diodes at cursors 3, 4, 5, and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown in figure 1. (Office Action, page 3, paragraph 4).

However, at column 4, line 65 to column 5, line 2, Kurata states, “Furthermore, although fluorescent lamps are used for directing light onto the cursor to detect the position thereof, a light emitting element such as a light emission diode may be provided at the cursor to detect the position thereof without using any fluorescent lamp.” By stating this, the Kurata reference appears to disclose using a light emission diode to direct light onto the cursor in order to detect the physical

position of the cursor, as an alternative to using the fluorescent lamps to direct light onto the cursor to detect the physical position thereof. Applicant respectfully submits that "at" is not equivalent to "on."

The Kurata reference does not describe, teach, or suggest "a scan window illumination device, wherein at least one of the plurality of moveable position markers includes a light source on the at least one of the plurality of markers and configured to direct light into at least one of the sides of the member," as provided in Applicant's independent claim 1, as amended. Support for this claim language can be found in Applicant's specification at page 15, lines 11-12 and Figure 4.

Applicant notes that the Examiner has only cited a single reference in support of the 103 rejection of all claims in the present application. Applicant submits that the description in Kurata is insufficient to describe, teach, or suggest the claims of the present application because each and every element and limitation is not explicitly or implicitly stated, unless combined with another reference or the Examiner's personal knowledge. In such case, Applicant respectfully requests that the Examiner provide a specific document or an affidavit to support an obviousness rejection.

As such, each and every element of independent claim 1, as amended, is not described, taught, or suggested in the Kurata reference. Accordingly, reconsideration and withdrawal of the § 103 rejection for the above independent claim 1, as well as those claims which depend therefrom, is respectfully requested.

Independent Claims 9, 13, and 21

The Examiner states on page 4 of the office action that arguments analogous to those presented for claim 1 are applicable to independent claims 9, 13, and 21. However, with respect to claims 9, 13, and 21, Applicant is unable to locate an indication from the Examiner as to where, in the Kurata reference, a description, teaching, or suggestion of **using a focused beam of light to trace at least a portion of a scan window perimeter** exists.

Applicant respectfully submits that the Examiner has not established a proper § 103 rejection for the following reasons. As provided above, at column 4, line 65 to column 5, line 2, the Kurata reference states, "Furthermore, although fluorescent

lamps are used for directing light onto the cursor to detect the position thereof, a light emitting element such as a light emission diode may be provided at the cursor to detect the position thereof without using any fluorescent lamp.” By stating this, the Kurata reference appears to disclose using a light emission diode to direct light onto the cursor in order to detect the physical position of the cursor, as an alternative to using the fluorescent lamps to direct light onto the cursor to detect the physical position thereof. The Kurata reference does not describe, teach, or suggest “a focused beam of light to trace at least part of a perimeter of the scan window”, as recited in independent claim 9 as amended.

Further, Applicant’s independent claim 13 recites in part:

a scan window illumination device configured to define the scan window with a perimeter, the scan window illumination device comprising a light source configured to generate a focused beam of light to trace at least part of the perimeter.

And, Applicant’s independent claim 21 recites in part:

tracing at least a portion of a perimeter of the scan window on the scanable surface using at least one focused beam of light

As such, each and every element of independent claims 9, 13, and 21, is not described, taught, or suggested in the Kurata reference. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection for the above independent claims 9, 13, and 21, as well as those claims which depend therefrom.

As mentioned above, the Examiner also states, “Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore, it would have been obvious . . . to provide light emission diodes at cursors 3, 4, 5, and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown in figure 1. (Office Action, page 3, paragraph 4).

However, figure 1 of the Kurata reference appears to describe a conventional image position determination apparatus sought to be improved by the position setting apparatus of Kurata. (column 1, lines 23-25 and column 2, lines 9-15). As discussed above, a light emitting diode appears to be used in the apparatus of the

Kurata reference in order to locate the physical position of a cursor without having to use a fluorescent lamp, but does not describe, teach, or suggest the elements and limitations presented above.

Based on the foregoing, Applicant respectfully submits that the Kurata reference does not support a proper obviousness rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection for the above independent claims 9, 13, and 21, as well as those claims which depend therefrom.

Allowable Subject Matter

Claims 11, 12, 19 and 20 were objected to as being dependent upon a rejected base claims, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for this indication of allowable subject matter.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Gregg W. Wisdom at (360) 212-8052 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 23rd day of March, 2006.

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